

Matus, et al.

S/N: 10/605,332

ELECTION

Applicant elects, with traverse, what the Examiner has characterized as "Invention I", deemed drawn to a MIG welding power source and a MIG welding system, and corresponding to claims 1-6 and 17-24.

REMARKS

The Examiner has identified three "inventions" in the pending claims and has classified these inventions into three Groups of claims. Group I consists of claims 1-6 and 17-24 deemed drawn to a MIG welding power source and a MIG welding system and classified by the Examiner in class 219, subclass 130.1. Group II consists of claims 7-16 deemed drawn to a method of regulating an inverter power source used by a MIG welding process and classified by the Examiner in class 219, subclass 130.33. Group III consists of claims 25-31 deemed drawn to a method of controlling the output of a MIG welding power source based on detecting a short circuit and classified by the Examiner in class 219, subclass 130.21.

MPEP §803 states that to support a restriction there must be a serious burden on the examiner if restriction is required. In short, it is not sufficient to allege that the identified "inventions" are independent or distinct as claimed, but the Examiner must also establish reasons for insisting upon restriction. "[I]n order to establish reasons for insisting upon restriction, [the Examiner] must show by appropriate explanation" that one of three recognized conditions exists. MPEP §808.02. Here, the Examiner has not provided valid reasons why a serious burden would result from examination of all three "inventions."

Reasons for insisting upon restriction exist if each Group is classified separately as having "attained recognition in the art as a separate subject for inventive effort" and would require a separate search, or if a different field of search exists for each Group such that it would be "necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists." MPEP §808.02 (Emphasis Added.) Since neither of these conditions exists with respect to the identified Groups, the Examiner has not established that a serious burden would result from examination of all Groups. When examination of an entire application can be done without any serious burden on the Examiner, "the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." MPEP §803.

The classifications of Group II and III are subsets of the classification of Group I. Further, the classifications do not seem to be consistent with the claimed subject matter.

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Specifically, the classification of Group I is labeled under "Metal Heating (subclass 50): By Arc (subclass 121.11): Including Arc Power Supplies." The classification of Group III is labeled under "Metal Heating (subclass 50): By Arc (subclass 121.11): Including Arc Power Supplies (130.1): With Automatic Output Control." The Examiner's classification of Group II is "Metal Heating (subclass 50): By Arc (subclass 121.11): Including Arc Power Supplies (130.1): With Automatic Output Control (subclass 130.21): Responsive to Both Arc Voltage and Arc Current." In short, the Examiner classified Group III in a subclass which is a subset of the classification of Group I, and classified Group II in a subclass which is a subset of both the classification of Group I and that of Group III. In addition, the subject matter called for in the claims of Group II appears to fall within the classification of "With Automatic Output Control" no less fittingly than the subject matter of Group III, and the subject matter of Groups II and III could reasonably have been categorized into the Group I classification. Furthermore, all three claim Groups regard MIG welding and MIG welding power sources in particular. That is, an examination of any of the claims of the Groups identified by the Examiner would necessarily include a search and consideration of references from at least each of the classifications identified by the Examiner. As such, a search and examination of all of the claims as originally filed would not place an undue burden on the Examiner.

For all these reasons, Applicant respectfully requests rejoinder of the claims of Group II and Group III with the claims of elected Group I. The Examiner is invited to call the undersigned to discuss this Election or any other matters regarding this application to further prosecution.

Respectfully submitted,



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